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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,291	04/19/2001	Chin Tae Kim	P-204	9587
34610	7590	10/11/2005	EXAMINER	
FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153			OYEBISI, OJO O	
			ART UNIT	PAPER NUMBER
			3628	
DATE MAILED: 10/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

*Office Action Summary*

Application No.

09/837,291

Applicant(s)

KIM ET AL.

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/08/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-3, 5-6, and 12 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Claims 1-3, 5-6, and 12 do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use a pencil and paper. Although, the applicant mentioned “the internet” in the preamble, but nowhere in the body of the claim did the applicant mention how the technological art (i.e., the internet) accomplish the recited steps in the body of the claim.

3. Claims 30-32 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter. The rejected claims appear to be directed to computer program/software.

Software, programming, instructions or code not claimed as encoded on computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Claims 30-32 are therefore rejected where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer. Examiner suggests that the applicant incorporate into Claims 30-32 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as failing to clearly set forth the metes and bounds of the said Claims 8-12. The said claims 8-12 are directed to the system. However, no structural element is recited in the body of the claim. Thus, the metes and bounds of the claims are not clear.
6. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, Claim 34 recites means for: entering; qualifying; identifying; and providing, but, since the claim does not set forth any steps involved in the method, it is unclear what method applicant is intending to encompass. A claim is indefinite where it merely recites a means for doing/using without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 20-26, 28-30, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by DE LA MOTTE et al ( DE hereinafter, U.S PUB. No.: 2003/0014318).

Re claim 20. DE discloses a method of matching vendors to buyers through a network, comprising: identifying whether vendors (i.e., suppliers) satisfy minimum attributes (i.e., suppliers are evaluated and rated in accordance with the standardized rating system, see abstract); registering the vendors (i.e., suppliers) that satisfy minimum attributes (see paras 0029-0030); identifying a buyer's vendor selection criteria (i.e., RFQ's, see paras 0013-0014); notifying vendors of the vendor selection criteria (i.e., the buyer sends RFQ's for presentation to the suppliers, see paras 0031-0032); accepting bids from vendors (see paras 0031-0032); and selecting a selected vendor from the vendors that satisfy minimum attributes according to one or more of the vendor selection criteria (i.e., buyers can activate software filters to screen offers based on product type, supplier, country of origin, etc. When a buyer finds an offer of interest, the buyer can either accept the offer or submit a counter-offer for presentation to the supplier, see paras 0032-0033).

Re claim 21. DE further discloses the method of matching vendors to buyers through a network, wherein the selection criteria comprises geographic region, business type or price (i.e., buyers can activate software filters to screen offers based on product type, supplier, country of origin, etc, see paras 0032-0033, also see paras 0021-0022).

Re claim 22. DE further discloses the method of matching vendors to buyers, further comprising notifying the selected vendor of having been selected (i.e., Once the buyer accepts the supplier's bid or counter-offer, an acceptance is transmitted to the supplier and the transaction proceeds toward completion, paras 0048-0049).

Re claim 23. DE further discloses the method of matching vendors to buyers through a network wherein the notification is through one of e-mail, file transfer protocol, integration technology, DCOM, XML, CORBA, HTTP, wireless devices or instant messaging (i.e., In any event, the RFQ is sent to each of the appropriate suppliers via the Internet such as by instant messaging, e-mail, see paras 0040-0041)

Re claim 24. DE further discloses the of matching vendors to buyers through a network, wherein the buyer provides the vendor selection criteria (i.e., RFQ's) and a database stores registered vendors that satisfy minimum attributes (see paras 0029-0030).

Re claim 25. DE further discloses the method of matching vendors to buyers through a network, wherein the buyer is prompted to input selection criteria through one or more capture forms (i.e., purchase order, see paras 0049-0050).

Re claim 26. DE further discloses a network based sales generation system, comprising: a spatial location engine (i.e., transaction facilitator) to determine criteria of a buyer and attributes of a plurality of vendors (i.e., Once a substantial number of RFQ's or bids are submitted to the transaction facilitator, the system

can build a profile defining what most buyers and suppliers consider to be minimally acceptable levels of quality, see paras 0074-0075); a registering unit to register vendors which satisfy set minimum attributes (see paras 0029-0030); a database containing information regarding the registered vendors (i.e., supplier registration database, see paras 0040-0041); an analyzing unit to collect selection criteria from the buyer (i.e., transaction server subsystems, see paras 0040-0041, also see 0045-0046); and an engine to select a qualified vendor for the buyer based on the database information and selection criteria (i.e., software filter, see paras 0032-0033).

Re claim 28. DE further discloses the network based sales generation system as further comprising: a vendor notification unit to notify registered vendors of selection criteria entered by the buyer (see paras 0046-0047); and a bid accepting unit to receive bids from the registered vendors (see paras 0045-0046), wherein the bids are stored in the database (see paras 0034-0035), wherein one of the bids and the selection criteria are capable of being jointly tendered by a plurality of cooperating parties (i.e., the remote terminals of buyers, suppliers, and third-party service providers, allows the establishment of a global, virtual marketplace for negotiating and executing sales of goods and services, see paras 0052-0053)

Re claim 29. DE further discloses the network based sales generation system as wherein the analyzing unit comprises a dynamically generated application form to be completed by the buyer and submitted to the engine (i.e., RFQ), wherein the



spatial location engine and the database use the data from the completed dynamically generated application form to select at least one qualified vendor (see paras 0040-0045).

Re claim 30. DE further discloses a network based selection system, comprising: a first logic unit to determine whether individual vendors meet a first set of minimum attributes (i.e., Once a substantial number of RFQ's or bids are submitted to the transaction facilitator, the system can build a profile defining what most buyers and suppliers consider to be minimally acceptable levels of quality, see paras 0074-0075); a registering unit to register vendors which satisfy set minimum attributes (see paras 0029-0030); and a second logic unit to determine a set of at least one vendor based on a second set of input criteria being applied to the individual vendors which meet the first set of minimum attributes i.e., activate software filters to screen offers based on product type, supplier, country of origin, etc, see paras 0032-0033, also see paras 0021-0022).

Re claim 34. DE further discloses a method for selecting a first party for a second party for engaging in a transaction, comprising: means for entering a request identifying at least one criterion for a transaction by the second party through a network (i.e., RFQ module in the transaction serve subsystem, see paras 0097-0102); means for qualifying the first party to a set of minimum attributes (i.e., Once a substantial number of RFQ's or bids are submitted to the transaction facilitator, the system can build a profile defining what most buyers and suppliers consider to be minimally acceptable levels of quality, see paras 0074-0075);

means for identifying a qualified first party to engage in the transaction based on at least one criterion(see abstract, also see software filter paras 0032-0033) ; means for providing an identification of the first and second parties to engage in the transaction(i.e., Preferably, each buyer, supplier, and third-party service provider gains access or "membership" to system 100 by registering with the system operator, the system operator typically will collect information regarding the identity of the participant, the party's financial information, the goods/services in which the participant trades, and etc, see paras 0029-0030).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's disclosure (see background of the invention).

Re claims 1-19. The applicant makes the following disclosure in the background of the invention "In a tender purchasing method in the related art, a company or an agency gives a public notice of a tender content such as an item, a tender method, tender date, tender place, or required documents, etc. After that, the responses to the tender are screened by hand, a bidder is selected on the basis of the screening result, and an order is placed. Recently, the purchasing

technology has been applied to the internet where a notice of tender is performed and tender documents are received over the internet. In other words, the notice of tender or documents acceptance, etc. performed by hand in the tender purchasing method in the related art is performed using the internet.”

Since Claims 1-19 merely recites the automation of the manual purchasing method stated supra, merely providing an automatic means to replace a manual activity (i.e., paper process) which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958). In other words, there is no enhancement found in the claimed step other than the known advantage of increased speed/efficiency. The end result is the same as compared to the manual method (i.e., ink and paper process). It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the recited steps in claims 1-19 because this would speed up the determining steps which is purely known and expected result from automation of what is known in the art.

11. Claims 27 rejected under 35 U.S.C. 103(a) as being unpatentable over DE.

Re claim 27. DE does not explicitly disclose the network based sales generation system wherein the registering unit comprises a dynamically generated application form to be completed by a vendor and compared to the set minimum attributes and stored in the database if the vendor meets or exceeds the minimum attributes. However, DE discloses registering with the system operator wherein the system operator typically will collect information regarding the

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identity of the participant, the party's financial information, the goods/services in which the participant trades, and etc (see paras 0029-0030), and this information may be stored in one or more databases. It is well known in the art that when data are stored in the database, they are usually stored in database query forms. Thus, it would be obvious to one of ordinary skill in the art to generate this form automatically using the system of DE in order for buyers and suppliers to have easy access the forms and to the data contained therein.

12. Claim 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE in view of Carlton-Foss (Foss hereinafter, U.S PAT 6,647,373).

Re claim 31. DE further disclose the network based selection system wherein each of the logic units includes a prescribed application program interface that allows rules and formulas contained inside an algorithm to be distributed across a wide area network (i.e., rating system, see paras 0087-0088), except for wherein the interface defines a type of data and a format of data that must be transferred to a distributed application over the wide area network. Foss discloses the network based selection system wherein the interface defines a type of data and a format of data that must be transferred to a distributed application over the wide area network (i.e., The reverse auction system 10 takes the information in the bid database 28, performs calculations, and transforms it into a human readable format, col.6, lines 10-40). Thus, it would have been obvious to one of ordinary skill in the art to combine DE and Foss6 in order to allow data to be presented to buyers and sellers in a format that is readable to

both parties; in order to monitor the progress of the auction, and to select zero or more winning proposals

Re claim 32. DE further discloses the network based selection system, wherein the interface is adapted to conform to existing logic products or specific logic that serve as general purpose algorithms (i.e., Thus, the buyers are able to customize the rating system to reflect their individual requirements. In addition, buyers may use both acceptable/critical characteristic designations and apply weightings to the characteristics to customize the overall rating system, see paras 0082-0084).

Re claim 33. DE further discloses the network based selection system wherein the interface allows the system to integrate with other protocols (i.e., transaction facilitator, see paras 0028-0029).

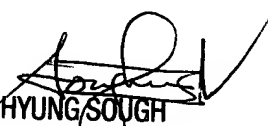
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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